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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re. Application No. 09/866,652
Art Unit: 3624
Examiner: Kyle, Charles R.

May 16th 2005

Dear Sir/Madam,

Enclosed please find the following materials relating to the above identified Application for U.S. Utility Patent in the name of Tommaso Innocenti of Prato, Italy:

Letter of Transmittal and Certificate of Mailing on: 1 sheet; (this one)

Reply Brief, filed under 37 CFR 1.193(b)(1) on: 11 sheets;

Total: 12 sheets.

Please file the above described materials enclosed in the above identified Application.
Thank you kindly for your service.

Respectfully yours,

Peter Gibson, Reg. #34,605, Customer #53373

Certificate of Mailing

I, Peter Gibson, Reg. Patent Agent #34,605, do hereby certify with my dated signature below that the above described materials are being deposited with the U.S. Postal Service in an envelope bearing sufficient postage as First Class Mail addressed to 'Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450' on the date indicated.

Peter Gibson, Reg. #34,605

May 16th 2005

REPLY BRIEF

A. Acknowledgment of Examiner's Answer

Appeal Brief Formal Requirements

1. Appellant respectfully acknowledges Examiner's indication that the present Brief in Support of Appeal correctly states the: status of both the claims and amendments after final rejection, summary of the claimed subject matter, grounds of rejection to be reviewed on appeal; and that the formal requirements of 37 CFR §§ 1.192(c)(1) - (7) were satisfied.

Action Made Final

2. Appellant respectfully and gratefully acknowledges Examiner's listing of the prior art of record and inclusion of a copy of the present Office action made Final.

Response to Appellant's Argument

3. Appellant respectfully acknowledges Examiner's 'Response to Appellant's Argument in the Appeal Brief' commencing at the bottom of page 15 of the Answer with a 'preliminary comment' that said brief "contains extensive argument that is frequently difficult to comprehend because of its complexity and verbosity", terminating on page 20 with the statement that "it is believed that the rejections should be sustained", and including a statement on page 17 recited below as providing an incisive key to appreciation of the failure of the Examiner's Answer to substantively address Appellant's arguments:

At page 8, Appellant refers to a possible Examiner's amendment to replace the word 'desired' with 'offered'. Appellant refers to this as a language 'informality'. In reality, such a substitution would completely alter the meaning of the Claim.

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B. Detailed Reply

1. Appellant respectfully submits the 'complexity and verbosity' noted by Examiner, particularly including a "six page long sentence ending at page 18" (Answer, p. 18), was utilized to demonstrate the "failure of the last Office action to address the rebuttal of the rejection of claims 40 - 64 except for" one single paragraph:

As to the 35 U.S.C. rejections, at section B, para. 2, (Applicant) appears to argue that *Lerner*, by not disclosing auction format specification, is precluded from disclosing an auction. The Examiner cited *Lerner* at paras. 117 and 121 as disclosing an auction which inherently has steps a. and b. at lines 14-17 of page 9 of the response. (p. 10, 3rd par.) (Brief in Support of Appeal, p. 13);

as demonstrated by recitation of said six page long sentence wherein bolded italics were used for emphasis of particular words or phrases as in the present Reply Brief:

5. Appellant respectfully submits, in demonstration of the failure of the last Office action to address the rebuttal of the rejection of claims 40 - 64 except for the one paragraph recited above, that the 'Response to Arguments' therein, after beginning with the blanket statement that "Applicant's arguments filed February 6, 2004 have been fully considered but they are not persuasive" (page 9) and ending in "Arguments presented by Applicant at other locations of the response are repetitive and addressed above" (page 13) consists of:

- a. referral to MPEP for change of correspondence address;
- b. acknowledgment of section A, Acknowledgment of Action, with a sentence: "At pages 1-8 of the Response, Applicant exhaustively discusses elements of the prior office action.";
- c. response to arguments concerning rejection under 35 U.S.C. 112 on pages 9 - 10;
- d. the paragraph recited above;
- e. erroneous accusation of irrelevant failure in argument:

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At para. 3, Applicant fails to explain why the features disclosed by *Moshal* and providing motivation in combine (sic) are not beneficial. *Applicant* quotes *Moshal* as disclosing configurability, flexibility and high capacity. Applicant fails to explain why these are not beneficial and why they would not provide a reason for the combination of references.

as Applicant actually pointed out that the "motivation attributed to the prior art ... is lacking" because *Moshal* "fails to specify any particular benefits, only 'multiple existing new types of auction' that 'may be created and conducted'" which can only be regarded as speculation in terms so general as to be suggestive of anything and hence nothing in particular;

f. repetition of an irrelevant, illogical, and wholly extraneous argument: "At para. 4, Applicant appears to suggest that different buyer and seller web sites provide some feature or advantage ... In this case, different sites increase the number of access points to the system and enhance accessibility" (pages 10 - 11); despite the fact that the presently claimed invention specifies "a web site accessible upon the world wide web" (claim 40, line 3), use of multiple sites for hosting is not even mentioned in the entire application, and the idea was rebutted with the argument that this "makes no sense: use of different web sites does not improve Internet accessibility";

g. omission of paragraph B.5 in response unless the repetition of the blanket statement: "Applicant's arguments are fully addressed considering all grounds of rejection" is an argument in response;

h. an erroneous statement combined with an irrelevant accusation:

i. "At para. 6, Applicant admits that provision of a sample is 'common commerce practice'"; and

ii. Applicant "fails to address why the Examiner's argument that such samples would help buyers evaluate potential sellers is incorrect";

as Applicant submitted that the rejection was "in error because Examiner admits that *Lerner* and *Moshal et al.* 'do not disclose direct

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1 *provision of a sample by a seller to a prospective buyer*” (B. 6, p. 11)
2 as the prior art cited as disclosing this, Conklin, just references a
3 common commerce practice wherein “the team usually flies to potential
4 vendor sites to evaluate capabilities and production facilities, obtain
5 samples, and then return home to evaluate the samples”; which practice
6 fails to disclose or suggest: direct provision of a sample, ‘a particular
7 commodity’, direct provision of a sample to indicate the quality of a
8 particular commodity, models of commodity quality desired, or use of
9 any of these elements in an online auction.

10 i. in response to B.7 repetition of the statement, first made re. par. 4, that:

11
12 obviousness can only be established by combining or
13 modifying the teachings of the prior art to produce the
14 claimed invention where there is some teaching,
15 suggestion, or motivation to do so found either in the
16 references themselves *or in the knowledge generally*
17 *available to one of ordinary skill in the art*
18

19 citing *In re Fine* and *In re Jones* without any actual argument
20 pertaining to any issue at all;

21 j. in response to B.8, verbatim repetition of the above citing *In re Fine*
22 and *In re Jones* without any actual argument pertaining to any issue at
23 all;

24 k. in response to B.9, verbatim repetition of the above citing *In re Fine*
25 and *In re Jones* without any actual argument pertaining to any issue at
26 all;

27 l. in response to B.10, verbatim repetition of the above citing *In re Fine*
28 and *In re Jones* without any actual argument pertaining to any issue at
29 all;

30 m. no response whatsoever to paragraph C.5, recited in full below as one
31 of the most important arguments presented by Applicant in rebuttal of
32 the rejection of present base claim 40:

33 5. Applicant respectfully submits that regardless of the fact
34 established by the declaration of prior invention under 37 CFR §1.131
35 that *Lerner* is not prior art a number of limitations to the present base

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claim, 40, from which all other present claims are properly dependent, are undisclosed by the combination of *Lerner* and *Moshal et al.* relied solely upon in rejection of said base claim including:

- a. providing, upon a web site ..., a proposal format *in which the type of auction can be specified* in addition to the particular commodity, weight, price, and specific commodity category dependent quality characteristics desired by a prospective buyer *in completion of a submission for initiating an open bid*;
- b. *providing the option of provision of a model* of a particular commodity desired for purposes of indicating the quality desired by a prospective buyer;
- c. providing, upon a web site accessible upon the world wide web, a proposal format *in which the type of auction can be specified* in addition to the particular commodity, weight, price, and specific commodity dependent quality characteristics offered by a prospective seller *in completion of a submission for initiating an open offer*;
- d. *providing the option of provision of a sample* of a particular commodity desired for purposes of indicating the quality desired by a prospective seller; by Examiner's own admission: "Lerner does not specifically disclose auction format specification" (5th OA, page 5, 3rd par., first sentence) hence denying the steps of specifying the type of auction in a proposal format in completion of a submission initiating either an open bid or offer as the motivation for combining the teachings of *Moshal et al.* consists of prior art speculation of "'multiple existing and new types of auction' that 'may be created and conducted'" (above, paragraph B.3); and "*Lerner and Moshal et al. 'do not disclose provision of a sample by a seller to a prospective buyer'*" (above, paragraph B. 6) and therefore cannot disclose the step of providing the option of provision of a sample or model. (Pages 18 - 19);
- n. no response whatsoever to paragraph C.6 or C.7 recited in full below as one of the most important arguments presented by Applicant in rebuttal of the rejection of claim 40:

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Applicant respectfully submits that the language of the four steps in present base claim 40 identified above, and of other steps thereto, patentably distinguish the presently claimed invention over the prior art by offering an online auction format for commodities that allows prospective sellers and buyers to specify the type of auction "in addition to the particular commodity, weight, price, and specific commodity category dependent quality characteristics desired" in a submission initiating either an open offer or bid, according to the originator, and provides for the option of providing either a sample or model representative of the quality offered or sought, respectively, by a prospective seller or buyer. (Page 19)

- o. the argument concerning inclusion of *Lerner* in the prior art discussed above in section C.1;
wherein it is seen that the main arguments presented by Applicant in rebuttal of repeated rejection of the present base claim concerning limitations in said base claim absent from and unsuggested by the prior art are wholly evaded except for the one paragraph recited in D.1 above.

2. Appellant respectfully recites, in further support of the above contention that the present Answer fails to rebut Appellant's argument supplied in the Brief in Support of Appeal, Examiner's rebuttal of this particular point:

At pages 12-13, Appellant states that his rebuttal was addressed in one paragraph in the Final Office Action. This is because the Examiner is succinct. The remainder of Appellant's comment in point 4 is unclear. (Examiner's Answer, p. 18)

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3. Appellant respectfully submits that Examiner is correct in stating that Appellant refers to the replacement of “the word ‘desired’ with ‘offered’ ... as a language ‘informality’”.

4. Appellant respectfully submits that the proposed Examiner’s Amendment would correct an informality because use of the word ‘desires’ instead of ‘offered’ comprised an inadvertent error as attested to by the prior association of the word ‘desires’ with ‘a prospective buyer’ in opposition to association of the word ‘offered’ with ‘a prospective seller’ in this sole base claim:

- a. “specific commodity category dependent quality characteristics *desired by a prospective buyer*” (lines 5 - 6),
- b. “indicating the quality *desired by a prospective buyer*” (line 7);
- c. “specific commodity dependent quality characteristics *offered by a prospective seller*” (lines 11 - 12).

5. Appellant respectfully submits that the opposition of ‘desired’ and ‘offered’ is essentially the same as the fundamental opposition, with regard to the basic terminology utilized throughout the entire specification, between an ‘open bid’ made by a ‘prospective buyer’ and an ‘open offer’ made by a ‘prospective seller’ also used in the base claim:

- a. “characteristics *desired by a prospective buyer* in completion of a submission for initiating an *open bid*” (base claim, lines 5 - 6);
- b. “characteristics *offered by a prospective seller* in completion of a submission for initiating an *open offer*” (base claim, lines 11 - 12);
- c. “comprising an *open offer* of said specified lot when initiated by a *prospective seller*

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1 and

- 2 d. comprising an *open bid* of said specified lot when initiated by a *prospective buyer*"
3 (base claim, lines 17 - 19).

4
5 6. Appellant respectfully submits that the association of buyer with bid, in opposition
6 to the association of seller with offer, is further utilized in the present base claim by the
7 limitations of "posting upon said web site, in association with said listing" (lines 23 & 26):

- 8 a. "*counter bids* received in response to an *open offer* and *counter offers* received in
9 response to an *open bid*" (lines 23 - 25); and
10 b. "*any offer* indications by said *prospective seller* in response to posted *counter bids*
11 and any *bid* indications by said *prospective buyer* in response to posted *counter*
12 *offers*" (lines 26 - 28).

13
14 7. Appellant respectfully submits that the fundamental opposition of bids with offers is
15 essentially the same as the opposition of prospective buyers with sellers, that this opposition
16 is fundamental an auction, and that by the same token replacement of 'desired' by 'offered'
17 by an Examiner's Amendment in the instance identified would correct an obviously
18 inadvertent mistake, for which reason the same is considered an informality.

19
20 8. Appellant respectfully submits that Examiner is therefore absolutely correct in stating
21 that the substitution of the word 'desires' with the word 'offered' "would completely alter
22 the meaning" involved as this substitution would make the phrasing concerned consistent
23 with the opposition of seller with buyer, of offer with bid, of 'offered' with 'desired'

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1 otherwise consistently followed throughout the present base claim:

- 2 a. “providing the option of provision of a *model* of a particular commodity desired for
3 purposes of indicating the quality desired by a prospective *buyer*” (lines 7 - 8);
4 b. “providing the option of provision of a *sample* of a particular commodity [desired]
5 offered for purposes of indicating the quality [desired] offered by a prospective
6 *seller*” (lines 13 - 14).

7
8 9. Appellant respectfully submits that the meaning of ‘providing the option of provision
9 of a model ... by a prospective buyer’ is clearly opposed to the limitation of ‘providing the
10 option of provision of a sample ... by a prospective seller’, that replacement of the word
11 ‘desired’ with the word ‘offered’ in the latter limitation would correct a language informality,
12 and that the diametrically opposed meaning identified by Examiner otherwise consistently
13 utilized throughout all the claims is both central and undeniable to the operation of any
14 auction for which reason a *model* is fundamentally different from, and opposed to, a *sample*.

15
16 10. Appellant respectfully submits that because a *model* is fundamentally opposed to a
17 *sample*, as the former can only be provided by a ‘prospective buyer’ and the latter can only
18 be offered by a ‘prospective seller’, it is impossible to support the contention that the two are
19 the same.

20
21 11. Appellant respectfully submits that:

- 22 a. the prior art fails to disclose the limitation of “providing the option of provision of a
23 model ... by a prospective seller”;

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- 1 b. the prior art does not suggest this limitation; and
2 c. it is error to equate a model with sample because, by Examiner's own admission, the
3 'meaning' of the word 'offering' is 'completely' different than the meaning of the
4 word 'desiring'.
5

6 12. Appellant respectfully submits that since the prior art does neither disclose nor
7 suggests the present base claim limitation of "providing the option of provision of a model
8 of a particular commodity desired for purposes of indicating the quality desired by a
9 prospective seller" (lines 7 - 8) and since the model of the presently claimed invention must
10 be opposed to, and can not be equated with, a sample the presently claimed invention is
11 patentably distinguished over the prior art by this limitation.
12

13 13. Appellant further respectfully submits that the present rejections made final and
14 presently appealed from essentially rely upon only two basic premises:

- 15 a. that the model of a particular commodity indicating the quality desired by a
16 prospective buyer is equivalent to or obvious in view of a sample offered by a
17 prospective seller; and
18 b. "providing the option of provision of a model" fails to comprise a valid claim
19 limitation because it is only an option and there is no warranty that a model is actually
20 provided:
21

22 14. Appellant respectfully submits that "providing the option of provision" is a valid claim
23 limitation as each party to an auction is exercising a choice. The provision of a previously

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Art Unit: 3624
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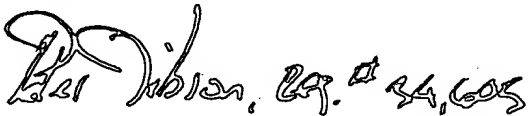
Examiner: Kyle, Charles R.
Appellant: Innocenti, Tommaso

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1 unknown option provides an hitherto unknown ability, a new function, and the necessity of
2 providing the option is certainly a requirement and hence a limitation that, in providing for
3 a new function, comprises a perfectly valid basis for allowance in view of the prior art.

4
5 15 Appellant respectfully submits that the present Reply Brief has been timely filed in
6 accordance with 37 CFR §1.193(b)(1).

7
8 Respectfully yours,

9 
10

11 Peter Gibson, Reg. #34,650, Customer No. 53373